

## REMARKS

### PRIOR ART REJECTIONS UNDER 35 USC 102:

The Examiner has rejected claims 44 and 46-51 as being anticipated by U.S. Patent No. 4,205,679 to Repke and claims 44 and 46-50 as being anticipated by Japanese patent No. 4-35498 to Kenji.<sup>2</sup> Applicants submit that pending claims 44 and 46-51 distinguish over Repke and Kenji.

#### **CLAIM 44:**

Claim 44 recites that “said at least one elastic member is substantially freely movable within said elongate passage.” This limitation is expressly distinguished from an elastic member that is intermittently joined to the sleeve member at spaced apart zones (compare claims 44 and 45 and see Specification at 11). In contrast, Repke discloses *intermittently* securing the elastic members to the elongate passage (Repke at Col. 8, line 1; Col. 9, line 6; Col. 15, line 22). The English portions of Kenji are silent as to whether the elastics are secured, but it appears at Figures 3 and 4 that the elastics are secured to the elongate passageway. For these reasons, Repke and Kenji fail to disclose or suggest all of the limitations of claim 44 and the Examiner’s rejection should be withdrawn.

#### **CLAIM 51:**

Claim 51 recites that “said outer cover comprises a liquid-permeable layer and a liquid-impermeable layer.” In contrast, Repke discloses an outer cover being formed from only a single layer (*see e.g.*, Repke at Col. 8, line 64, panty is “constructed from a single blank,” Figure 11). The Examiner’s recitation of and reliance on Col. 9, line 11 et seq. and Col. 9, line 41 et seq. is misplaced.

In particular, the layer 264 is an absorbent layer, not a portion of the outer cover, and the facing which “enveloped” the absorbent layer 264 is at most a liner. Indeed, the Examiner applied the layer 264 as the absorbent structure and the enveloping facing as the

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<sup>2</sup> It is unclear from the record whether the Examiner has considered an English language translation of the abstract for Kenji. Accordingly, Applicants have provided a copy of an English language abstract for Kenji as noted in the enclosed Supplemental Information Disclosure Statement and Form PTO-1449.

liner with respect to claims 44 and 46-51 generally (see Office Action at 3, lines 3-5). As such, the absorbent layer and enveloping facing cannot also form different layers of the “outer cover,” which is a separate element from the liner and absorbent structure as recited in claim 51. With respect to the Examiner’s recitation of Col. 9, lines 41-49, the materials all appear to be liquid-impermeable, and do not include a liquid-permeable layer as recited in claim 51. Moreover, the facing referred to in Col. 9, lines 51-58 appears to be the liner previously referred to in lines 11-13, and there is no disclosure or suggestion that it refers to another layer of the outer cover.

Finally, the Examiner has rejected claim 51 under 35 USC 102, and the recitation of, and reliance on, additional references (Office Action at 3-4, citation of USP 4,756,709, 4,816,025, etc.) is misplaced. Under 35 USC 102, all of the claim limitations must be found in a single reference. Moreover, and given the lack of detail provided by the Examiner with respect to those references, Applicants cannot ascertain what features in those references are being relied upon or the propriety of combining such a reference with Repke.

For all of these reasons, Repke fails to disclose or suggest all of the limitations of claim 51 and the Examiner’s rejection should be withdrawn.

#### **CLAIMS 46-50:**

Applicants submit that the materials of Repke and Kenji do not inherently function the same as the claimed inventions of claims 46-50. First, it is black letter law that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic” (MPEP 2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1944, 1957 (Fed. Cir. 1993)). “Inherency may not be established by probabilities or possibilities” (MPEP 2112, citing *In re Roberston*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

In the present case, the claims are directed to the waist elastic system, not just the elastic material referenced by the Examiner (Office Action at 4). While keeping the creep of the elastic members to a minimum may help reduce decay of the overall system, other factors including the construction of the sleeve member and the attachment of the elastic member also play a significant role (Specification at page 9 lines 5-12). For example, the elastic member may be substantially unconnected along its length, or connected to only one layer of

material (*id.*; Specification at page 43, lines 4-10). Accordingly, the simple recitation of various elastic materials in Repke, for example, does not necessarily mean that the claimed decay values will be achieved. Indeed, as set forth below, Applicants' invention exhibited significantly improved decay values when compared with other commercial products. For all of these reasons, the Examiner's rejections relative to claims 46-50 should be withdrawn.

## **PRIOR ART REJECTIONS UNDER 35 USC 103:**

### **CLAIMS 40, 43, 45 and 52:**

In the outstanding Office Action, the Examiner has now rejected claims 40, 43, 45 and 52 under 35 USC 103 as being obvious over Repke or Kenji, each taken alone, rather than rejecting the noted claims under 35 USC 102 over the same references as was done in the prior Office Action. Applicants respectfully submit that the Examiner's rejections should be withdrawn for the reasons set forth below. In particular, the Examiner has failed to make out a *prima facie* case of obviousness since (1) neither reference discloses all of the limitations of the noted claims and (2) there is no suggestion to modify either reference as suggested by the Examiner (see MPEP 2143).

#### **Failure to Disclose All Limitations:**

Claim 40 recites that "said surface of said extension portion to which said end portion is joined comprises said second surface of said outer cover," wherein the second surface is located opposite the "first surface facing said liner." As disclosed in Repke and Kenji, the surface of the extension portion to which the end portion is joined comprises the *first surface* facing the liner. Moreover, Kenji fails to disclose or suggest that the extension portion is secured to itself. Rather, the extension portion is joined to the top sheet 2 (see abstract and Figure 3). For these reasons, Repke and Kenji fail to disclose or suggest all of the limitations of claim 40, and 43, 45 and 52 depending therefrom, and the Examiner's rejections should be withdrawn.

#### **No Suggestion To Modify Repke or Kenji:**

The Examiner asserts that one of skill in the art would have found it obvious to join the extension portion to the second surface of the outer cover, referring only to Applicants' specification and stating that "one of skill in the art would have expected applicant's

invention to perform equally well with either configuration because both form a passage for the elastic” (Office Action at 5). The teaching of Applicants’ invention is totally irrelevant, however, to whether there is a suggestion to modify Repke or Kenji. Indeed, the Examiner’s statements are a classic example of using improper hindsight analysis to arrive at Applicants’ invention. *See In re Deminski*, 796 F.2d 436, 443 (Fed. Cir. 1986) (“The only way the board could have arrived at its conclusion was through hindsight analysis by reading into art [Applicants’] own teachings. Hindsight analysis is clearly improper, since the statutory test is whether ‘the subject matter as a whole would have been obvious at the time the invention was made.’”); *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) (“It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.”)

Moreover, in this instance, the prior art actually teaches away from the proposed modification. In particular, Kenji discloses that the purpose of the invention is “to keep a discharge liquor from being retained at the opening of a waist while *preventing leakage of the excrement at the opening of the waist*” (see Abstract) (emphasis added). Kenji further discloses that the cuffs 20A and 20B are “extended toward the crotch part from below the waist opening *inside* the waist opening” (Abstract) (emphasis added). In this way, the cuffs are required to extend inwardly to act as a gasket. Accordingly, Kenji teaches away from securing the cuffs to the opposite side of the outer cover, and the Examiner’s rejections should be withdrawn.

Repke also lacks any motivation to fold the edges 234, 236 in the opposite direction. Indeed, in view of the teachings of Kenji, and the lack of any motivation to reverse the fold save for Applicants’ own teachings, the Examiner’s rejections should be withdrawn.

#### **CLAIMS 46-50:**

##### **No Suggestion to Combine Repke or Kenji with Weil:**

There is no suggestion to combine either Repke or Kenji with Weil as asserted by the Examiner. Importantly, Weil actually teaches against a “closed-loop system” as recited in claims 46-50. In particular, Weil discloses that:

it has been found that absorbent articles having elasticized waistbands also have a tendency to sag/gap and slide/slip during use. Further, the elasticized waistband feature has a tendency to rollover or roll-in at the front of the diaper

resulting in a lack of fit about the waist of the wearer. (Col. 1, lines 63-67).

To solve this problem, Weil teaches the use of the dual tension fastening system described above. In particular, as stated by Weil, “it is an object of [the Weil invention] to provide a fastening system that provides [a] sustained dynamic fit for the elasticized waistband, . . . [and] to provide a waist closure system that maintains/creates lateral tension through at least a portion of the elasticized waistband to provide sustained dynamic fit” (Col. 2, lines 22-29). Therefore, while Weil discloses the disadvantages of known waist elastic systems in terms of sag/gap and slide/slip during use, Weil teaches that such problems are solved by providing a dual tension fastening system (using 2 pairs of adjustable fasteners), neither of which is a closed-loop system. Weil does *not* disclose or suggest that the problems of sag/gap/slides/slips are solved by forming a closed-loop system and reducing the decay in such a system as recited in claims 46-50.

Moreover, substitution of only the discrete lengths of elastic (which do not surround the user) as taught by Weil into the structure of Repke or Kenji would not provide a closed-loop elastic system and would be deficient in that the garment would not be securely held to the user. Indeed, such a substitution would render Repke and Kenji unsatisfactory for their respective intended purposes (MPEP 2143.01).

In this regard, it is important to remember that the Examiner must read Weil as a whole. Weil teaches the use of a releasable dual fastener system having discrete lengths of elastic and adjustable fasteners to solve the problem of sag/slips, etc. Therefore, it is improper to take only the teaching of “elastic elements” in Weil, and to thereafter modify the construction of Repke and/or Kenji with hindsight analysis in view of Applicants’ claims.

In summary, there simply is no suggestion to combine Repke or Kenji with Weil as set forth by the Examiner, and claims 46-50 should be passed to allowance.

**The Claimed Decay Values are Not An Obvious Matter of Design Choice:**

As set forth above, the claims recite decay of the “waist elastic system,” which includes the elastic member *and* the elongate sleeve member disposed thereabout (see Claim 40). While keeping the creep of the elastic members to a minimum, as taught by Weil, may help reduce decay of the overall system, other factors including the construction of the sleeve

member and the attachment of the elastic member also play a significant role (Specification at page 9 lines 5-12). For example, as previously explained, the elastic member may be substantially unconnected along its length, or connected to only one layer of material (*id.*; Specification at page 43, lines 4-10).

In addition, Weil fails to disclose any specific values of the magnitude of decay, but rather discloses only generally the objective of minimizing the creep of the elastic members. While the Examiner attempts to circumvent the requirement of all limitations being disclosed or suggested in the references by referring to design choices, that strategy is deficient on several grounds.

As a threshold issue, the Examiner has not presented any line of reasoning as to why an artisan of ordinary skill would have been motivated to make the distinctive changes and modifications required to derive the invention called for by Appellant's claims. The Examiner's mere assertion that the claimed configuration "would have been an obvious matter of design choice within the skill in the art" presents only a conclusion, rather than a reason for making such a modification, or a suggestion that the claimed results could thereby be achieved. Instead, the Examiner has impermissibly employed the Applicants' disclosure as a road map for picking and choosing ranges of decay values that are neither taught nor suggested in the prior art. It is well settled that an obviousness rejection based on such hindsight analysis is improper.

Furthermore, and contrary to the Examiner's assertions (Office Action at 7 and 8), Applicants have provided numerous references to the criticality of the claimed decay values in the specification. For example, Applicants explained that "another important factor in providing a substantially uniform low tension over a wide size range, a more comfortable fit, and improved ease of use, is the maximum magnitude of decay, measured in grams of tension, at a specific extension over the first three cycles" (Specification at page 40, lines 9-21). Moreover, Applicants tested multiple samples of a first and second embodiment of the invention, and compared the decay values with the decay values for multiple specimens of seven commercially available products (Specification at page 41, lines 4-13). The extensive testing is reflected in the thirteen tables of data provided in the Specification (pages 18-30). The commercially available products that were tested are described in the Specification at

pages 15-16, and include a Pampers® Trainers® product manufactured by Procter and Gamble, the assignee of the Weil patent (Specification at page 16, lines 1-4).

As can be seen at Table 13, the decay values for the embodiments of the present invention are “*significantly lower* than the decay values at 300 millimeters for samples 1-7 [commercial products]” (page 41, lines 4-10 (emphasis added)). The difference in decay values for other extensions were equally significant (see Table 13). This objective evidence of non-obviousness, which shows the failures of others as well as unexpected results, dictates a finding of patentability. It is important to note that the comparisons of Tables 1-13 are *direct* comparisons of the *closest* prior art with the claimed invention, including the measures of decay of the elastic system. *See* MPEP 716.02(e) (citing *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex Parte Humber*, 217 USPQ 265 (Bd. App. 1961)). In contrast, the general discussion of creep in Weil is not even directed to a closed-loop *system*, but rather only to the individual elastic members, and is therefore not applicable to the claims at issue. As such, the claimed ranges of decay, which do not even come close to overlapping with the decay of the known commercial products, strongly evidences the criticality of the ranges, and obviates against any suggestion that they can be achieved simply by design choice.

For these additional reasons, claims 46-50 should be allowed.

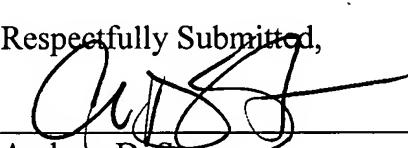
#### **CONCLUSION:**

If for any reason this application is not considered to be in condition for allowance and an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to call the undersigned attorney at (312) 321-4713.

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By:

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